

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

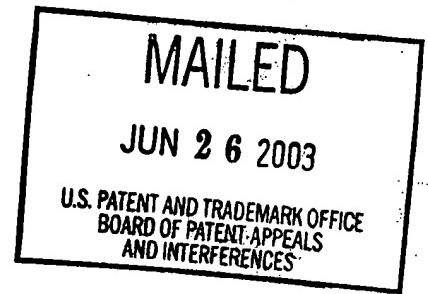
Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* M. ASHRAF IMAM,  
BHAKTA B. RATH and TEDDY M. KELLER

Appeal No. 2002-0482  
Application 08/845,897



ON BRIEF

Before PAK, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*REMAND TO THE EXAMINER*

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 1, Feb 2003; 1200-29 – 1200-30).

Even a cursory comparison of appellants' reply brief filed May 15, 2001 (Paper No. 29), with their supplemental appeal brief filed February 16, 2001 (Paper No. 25), shows that appellants presented significantly different information and arguments in the reply brief with respect to the grounds of rejection set forth in the final Office action mailed April 19, 2000 (Paper No. 16), and advanced on appeal in the answer mailed April 10, 2001 (Paper No. 28). Indeed, in addition to a new explanation of the claimed invention, appellants for the first time present arguments based on specific disclosure in the references as well as specific interpretation

of the appealed claims based on the specification. The examiner entered the reply brief, noting the same and forwarding the application to the Board in the communication mailed January 23, 2002 (Paper No. 31).

Thus, the record on appeal now contains substantial new arguments by appellants aimed at the basic factual underpinning of the examiner's grounds of rejection of the appealed claims to which the examiner has not responded.<sup>1</sup> To the extent that a *prima facie* case of anticipation and obviousness had been made out by the examiner over the references as applied in the grounds of rejection advanced in the answer, the new factual arguments by appellants in rebuttal in the entered reply brief shifted the burden back to the examiner to again establish the factual underpinning of a *prima facie* case under 35 U.S.C. §§ 102 (b) and 103(a) on the record as a whole in order to maintain the grounds of rejection. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990).

Accordingly, pursuant to our authority in 37 CFR § 1.193(b)(1) (2003), we hereby remand this application to the examiner to prepare a supplemental answer for the purpose of responding to the new argument presented by appellants in the reply brief, or to take any other appropriate action consistent with current examining practice and procedure, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

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<sup>1</sup> Under 37 CFR § 1.193(b)(1), the examiner does *not* have the option in the first instance to deny entry of the reply brief where appellants have presented arguments that are *not* limited to new points raised by the examiner in the answer.

This application, by virtue of its “special” status, requires immediate action. See MPEP § 708.01(D) (8th ed., Rev. 1, Feb 2003; 700-121). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. See, e.g., MPEP§ 1211 (8th ed., Rev. 1, Feb 2003; 1200-30).

*Remanded*

*Chung K. Pak*  
CHUNG K. PAK  
Administrative Patent Judge

*Charles F. Warren*  
CHARLES F. WARREN  
Administrative Patent Judge

*Peter F. Kratz*  
PETER F. KRATZ  
Administrative Patent Judge

BOARD OF PATENT  
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